

**REMARKS**

In further response to the final Office Action, Applicants herein provide the following amendments and remarks. Applicants respectfully thank the Examiner for holding a telephone interview with Applicants' representative. The Examiner's kind remarks have been incorporated herein.

Please note claims 2 and 5 are amended and claims 3-4 and 6-7 are cancelled without prejudice or disclaimer.

The Examiner is respectfully referred to the comments shown in the March 30, 2009 response.

In particular, the Examiner is again respectfully requested to review the Declaration submitted with the previous response. The Declaration is by a person of skill in the art and includes an attached publication (Hamamoto et al.). Such Declaration and attached reference show that undue experimentation was required in order to obtain the high yield processes of the claimed invention.

For further example, it is noted that in Comparative Example 1 which ends on page 28 of the specification, only 6.28 mM CMP-NeuAc was produced. On the other hand in Examples 1 and 2 of the specification, which are embodiments of the independent claims of the claimed invention, 21.4 mM CMP-NeuAc or 25.6 mM CMP-NeuAc was produced. Such is a surprising and unexpected increase in yield of the end product which is an inherent feature of the claimed process.

Furthermore, to more particularly recite the claimed invention, claims 2 and 5 are amended. Support for such claim amendments can be found on pages 13-14 of the specification as filed. Such amended claims further define the amount of enzyme for the claimed process. It is respectfully noted that such are not taught or suggest by the cited art.

Finally, it is noted that under the recent Supreme Court Decision in KSR, a claimed invention can be rendered obvious if there are a finite number of combinations in the prior art. However, it is noted that in this case, a skilled artisan would be confronted with an almost infinite number of possible combinations as shown in the Hamamoto reference. Further, the

results of such proposed combinations are unpredictable as indicated by the Declaration. Thus, Applicants respectfully suggest that the claimed process cannot be obtained by routine experimentation and is not obvious under KSR.

### **CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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